

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: A9381

Gary BEE, et al.

Application No.: 09/880,732

Group Art Unit: 1634

Confirmation No.: 4949

Examiner: Diana B. Johannsen

Filed: June 12, 2001

For: ASSAY FOR GENETIC POLYMORPHISMS USING SCATTERED LIGHT
DETECTABLE LABELS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is a Request for a Pre-Appeal Brief Conference to formally review the rejections in the Final Office Action of 9 February 2007.

Basis For Review

Applicants request formal review of the written description rejection of claims 1-6, 9 and 59-71 under 35 U.S.C. §112, first paragraph.

Discussion

The Office Action of 30 June 2006, rejected claims 1-6, 9 and 59-71 under 35 U.S.C. §112, first paragraph, as allegedly “failing to comply with the written description requirement.” *Office Action of June 30, 2006*, page 2. Specifically, the Action stated that the claims “contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” *Office Action of June 30, 2006*, pages 2-3. Applicants respectfully disagree with the assertion that the specification as filed does not fully support the presently claimed invention.

To support this notion that the specification does not evince possession of the claimed invention, the Office Action appears to be searching for, and requiring, the presence of *ipsis verbis* support in the specification for claim 1. Such a description, however, is not required in

the specification to support the claims. Rather, “the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 1999). Indeed, the standard for determining if a specification complies with the written description requirement is that “the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991) (quoting *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)).

Accordingly, Applicants assert that the specification as filed would allow one of ordinary skill in the art to recognize or visualize that presently claimed invention. As highlighted in the Amendment under 37 C.F.R. §1.114, filed 5 April 2006, the specification provides ample support for illuminating the particles using white light when it states that “different colors of scattered light [can be generated upon] illumination of polychromatic light, such as white light.” U.S. Pregrant Publication No. 2002/0127561, ¶0056. The specification also provides support for the concept that the illuminating light, which may certainly include white light, can be non-evanescent when it states that “the methods of this invention [may] use illumination with non-evanescent wave light,...” U.S. Pregrant Publication No. 2002/0127561, ¶0046. Further, there is no explicit teaching or even suggestion that, when white light is used as the illuminating light, the wave light must not be evanescent. Thus, one of skill in the art would easily recognize and be able to visualize that the non-evanescent light that is used to illuminate the particles may also be white light. Accordingly, the specification taken as whole would allow one of skill in the art to visualize the presently claimed invention. Applicants earnestly solicit reconsideration and withdrawal of the written description rejection.

In spite of the arguments presented above, the Final Office Action of 9 February 2007 maintains the written description rejection because “there is no disclosure (be it express, implicit or inherent) of a particular type or subcategory of white light that is ‘not an evanescent wave light’” *Final Office Action of 9 February 2007*, page 5. In maintaining the rejection, the Final Office Action agrees that the application as filed discloses methods using white light, and

agrees that the application as filed discloses “methods [that] use illumination with non-evanescent wave light.” Nonetheless, the Office Action maintains the rejection because the specification allegedly fails to support the use of non-evanescent white light.

The Final Office Action states that it did not look for *ipsis verbis* support when formulating and maintaining the rejection. But it appears, however, that the Office is, in fact, looking for *ipsis verbis* support. Indeed, the Office Action agrees that specification teaches the use of white light; it also agrees that the specification teaches the use of non-evanescent light. Yet the Final Action maintains the rejection even though the Action claims to have considered the specification, “as a whole.”

Written description support for claims is found when one of skill in the art, after reviewing the specification as a whole, would be able to envision or recognize the invention as claimed. See *Vas-Cath*, 935 F.2d at 1563. Applicants maintain that the specification as a whole provides ample support for the present claims to one of skill in the art. The specification explicitly states that, without limitation, non-evanescent wave light can be used to illuminate. U.S. *Pigrant Publication No. 2002/0127561*, ¶0056. The specification states that white light, without limitation, can be used to illuminate. U.S. *Pigrant Publication No. 2002/0127561*, ¶0046. Thus, the specification specifically teaches the use of white light and non-evanescent light.

The Office Action’s arguments against descriptive support for the claims can be summarized by stating that one of skill in the art would be able to read the above statements and visualize the use of white light, and the use of evenascent light. But the skilled artisan would, somehow, not be able to recognize the use of evanescent white light. This conclusion could only be supported if *ipsis verbis* support is required for proper written description support. Requiring *ipsis verbis* support is not the standard and is improper when reviewing a specification for adequate written description.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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